



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/897,480

07/03/2001

Michio Matsuura

1083.1082

2498

21171

7590

09/13/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

SHIFERAW, ELENI A

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,480

Applicant(s)

MATSUURA ET AL.

Examiner

Eleni A. Shiferaw

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to canceled claim 12-14, and 20, and presently pending claims 1-11, 15-19, and 21, filed on June 11, 2006 have been fully considered but they are not persuasive. The examiner would like to point out that this action is made final (MPEP 706.07a).

Response to Arguments

2. The Applicant's first argument concerns Yokono et al. reference failure to disclose, "*contents are encrypted based on the identifier, page 9 lines 13-19 of the Remark*", as recited in claims 1-2, 7-8, 10, 15-19, and 21. The examiner respectfully disagrees with the Applicant's contentions and would like to draw the Applicant's attention to col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15 wherein Yokono et al. discloses a method of public downloading apparatus, and the method comprising: a user purchases a disk and registers the disk, based on **serial number/medium ID** of the disk and user identification, to download contents to user's disk, with public downloading apparatus management company 2, and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus 1 checks the disk serial number and user identification, then if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 based on the medium ID and stored in public downloading apparatus 1 and the public downloading apparatus extracts user requested content and enciphering the extracted content based on medium ID, user ID and password (see, col. 23 lines 8-col. 24 lines

65, and col. 17 lines 45-49 of Yokono et al.). Moreover, Yokono et al. discloses a user purchasing a disk 90 that has serial number or medium ID information stored in it, when a user inserts the disk 90, the public downloading apparatus 1 reads the medium ID of the disk 90 and other information (user ID and password) provided by the user, **and the downloading apparatus 1 enciphers the medium ID, and other information based on the disk 90 medium ID information** (see, fig. 11, col. 19 lines 59-col. 20 lines 67, and col. 23 lines 2-55). Moreover, Applicant is provided a second the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **JP2000285591 Kobe Steel LTD, Nishinaga Koichi et al discloses information distribution terminal 10 ciphering information based on intrinsic IDENTIFICATION information of attachable/detachable devices and charging clients for required information.** Moreover, the Applicant has agreed that enciphering a content based on "SERIAL NUMBER" is well known. The Applicant has admitted/not argued that it is well known to encrypt data based on identifier data/serial number. The Office has provided an Office Action, that includes reference Spruit et al. PG PUBS 2001/0030932 A1, on 09/12/2005 last paragraph of pages 3-par. 2 of page 4, that discloses **providing a unique serial number to optical discs and DVDs at manufacturing and encrypting content data based on the unique serial number of the medium, by content provider.**

As per Applicant's concerning reference Yokono et al. failure to teach, "*limiting condition, page 9 last paragraph-page 10 lines 2*" as recited in claims 1-2, 7-8, 10, 15-19, and 21. The examiner respectfully disagrees with the Applicant's contentions. First, this limitation cannot be argued for claims 7, 11, 16, and 21 because it is never claimed. Second, Yokono et al. discloses "**use record information**" that is an information, recorded on the medium, about the

details of the use of public downloading apparatus 1 recorded each time public downloading apparatus 1 is used with the disk 90. Each time the use of the public downloading apparatus 1 is finished, the contents of the use record information are updated (a new use record is added) by public downloading apparatus 1 (see, col. 15 lines 55-col. 16 lines 66). Moreover, the Applicant's argument is not convincing because the Office has disclosed Peinado et al. reference in the Office Action mailed on 09/12/2005 page 3 lines 11-12 to discloses the very well-known license term conditions.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11, 15-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokono et al. USPN 6,529,946 B2.

Regarding claims 1, 2, 7, 8, 15, 16, 18, and 21, Yokono et al. teaches the a method/system/apparatus/product for providing contents to a user (fig. 1), comprising:

a recording device for recording contents on a medium (col. 6 lines 43-61; *public downloading apparatus 1 recording electronic information to users disk*); and

an execution device for reproducing, displaying or executing the contents recorded on the medium (col. 29 lines 47-54; *public downloading apparatus reproducing data from the disk 90*), wherein the recording device includes a processor (fig. 1) capable of performing the following operations:

storing contents in advance in conjunction with first specifying information for specifying the contents requested by the user (col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15; *user purchases a disk and registers the disk, based on **serial number/medium ID** of the disk and user identification, to download contents to user's disk, with public downloading apparatus management company 2, and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus 1 checks the disk serial number and user identification, then if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 and stored in public downloading apparatus 1*);

accepting first specifying information (col. 7 lines 55-col. 8 lines 3 and col. 14 lines 53-65; *public downloading apparatus accepting user required content downloading information from user and content is identified by **download ID***);

accepting fees for recording the contents on the medium (col. 8 lines 4-col. 10 lines 25 and fig. 1 element 3; *public downloading apparatus accepting fees for recording electronic information from users*);

extracting the stored contents, based on the accepted first specifying information (col. 5 lines 10-col. 6 lines 61; *contents like daily electronic newspaper, news magazines, books, music*

are extracted from the contents server 4 and provided/stored into public downloading apparatus 1 to be extracted and recorded to users personal disk);

reading an identifier having been given uniquely to optional (fig. 13 *unique MEDIUM ID*) medium prepared by the user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number of the disk is read by the public downloading apparatus 1 and/or public downloading apparatus management company 2*);

encrypting the extracted contents, based on the read identifier (col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49; *public downloading apparatus extracting user requested content and enciphering the extracted content based on medium ID, user ID and password*);

recording the encrypted contents on the medium prepared by the user (col. 17 lines 45-49; *recording encrypted user contents on users disk*);

accepting a limiting condition for reproducing, displaying or executing the contents by the user (col. 15 lines 64-col. 16 lines 66; *use record information public downloading apparatus 1 accepting starting and finishing time...date...month...year...hrs...min...seconds...*); and

recording the accepted limiting condition on the medium prepared by the user (fig. 8 and col. 15 lines 64-col. 16 lines 66; *recording use record info on the user's disk*), wherein the execution device includes a processor capable of performing the following operations:

reading the identifier of the medium prepared by the user (col. 15 lines 11-66, col. 18 lines 45, and fig. 13; *reading medium ID/serial number of the user's disk*);

decrypting the contents recorded on the medium prepared by the user in an encrypted form, based on the read identifier (col. 23 lines 8-col. 24 lines 65; *deciphering contents recorded on the user disk*); and

reproducing, displaying or executing the decrypted contents under the limiting condition recorded on the medium prepared by the user (col. 29 lines 47-col. 54, and col. 10 lines 22-25).

Regarding claims 10, 17, and 19, Yokono et al. teaches an execution device/product for reproducing, displaying or executing contents to be provided to a user recorded on a medium (fig. 1) , comprising:

a processor capable of performing the following operations:

reading an identifier having been given uniquely to an optional medium prepared by the user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number of the disk is read by the public downloading apparatus 1 and/or public downloading apparatus management company 2*);

decrypting contents, which have been encrypted based on the identifier and recorded, based on the read identifier (col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49; *deciphering contents encrypted based on serial number, and recorded on the user disk*); and

reproducing, displaying or executing the decrypted contents under a limiting condition for reducing, displaying or executing the contents recorded on the medium prepared by the user (col. 29 lines 47-col. 54, and col. 10 lines 22-25).

Regarding claim 20, Yokono et al. teaches a central device/product for transmitting contents to be provided to a user to another computer connected via a communication network, comprising a processor capable of performing the following operations:

accepting first specifying information for specifying contents requested by the user (col. 7 lines 55-col. 8 lines 3 and col. 14 lines 53-65; *public downloading apparatus accepting user required content downloading information from user and content is identified by **download ID***), second specifying information for specifying another computer in which the contents are to be recorded (col. 5 lines 10-col. 6 lines 61; *there are multiple public downloading apparatus and when the user purchases a disk and provides the disk to one of the downloading apparatus 1, the downloading apparatus is specified and content from content server is sent to the specified downloading apparatus to be downloaded to user's disk*) and an identifier having been given uniquely to each optional medium prepared by the user, transmitted from the outside (col. 15 lines 11-66 and col. 18 lines 45);

extracting contents from a content database storing contents, based on the accepted first specifying information (col. 5 lines 10-col. 6 lines 61; *contents like daily electronic newspaper, news magazines, books, music are extracted from the contents server 4 and provided/stored into public downloading apparatus 1 to be extracted and recorded to users personal disk*); and

transmitting the extracted contents and the identifier to another computer associated with the second specifying information (col. 5 lines 10-col. 6 lines 61).

Regarding claims 3 and 11, Yokono et al. teaches the contents processing system, further comprising a central device connected to the recording device and the execution device via a communication network (fig. 1), wherein

the processor of the execution device is further capable of performing the following operations:

accepting first specifying information (col. 7 lines 55-col. 8 lines 3 and col. 14 lines 53-65; *public downloading apparatus accepting first specifying info.*);

accepting second specifying information for specifying a recording device in which the contents are to be recorded (col. 5 lines 10-col. 6 lines 61; *public downloading apparatus accepting first specifying info.*); and

transmitting the accepted first specifying information, second specifying information and the identifier having been given uniquely to the medium prepared by the user to the central device (col. 5 lines 10-col. 7 lines 67), wherein

the central device includes a processor capable of performing the following operations:

extracting contents from a content database storing contents, based on the transmitted first specifying information (col. 5 lines 10-col. 6 lines 61); and

transmitting the extracted contents and the transmitted identifier to a recording device corresponding to the transmitted second specifying information (col. 5 lines 10-col. 7 lines 67), and

the processor of the recording device is further capable of performing the following operations:

storing the transmitted contents in the content file in conjunction with the identifier (col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15); and

extracting the contents from the content file based on the identifier of the medium prepared by the user (col. 5 lines 10-col. 6 lines 61).

Regarding claim 4, Yokono et al. teaches the contents processing system/apparatus, wherein the contents are web pages, and the first specifying information is a search

searching for web pages, and the processor of the central device extracts a web page corresponding to the transmitted search keyword and web pages linked to the web page from the content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1). One would have been motivated to modify the Yokono's electronic information to web page because it would include web content to be provided to users.

Regarding claim 5, Yokono et al. teaches the contents processing system/apparatus, wherein the processor of the central device is further capable of performing an operation of accepting a limit number of times for limiting the number of times of linking between the web page corresponding to the search keyword and web pages linked to the web page, and the processor of the central device extracts the web page corresponding to the transmitted search keyword and web pages linked to the web page within the accepted limit number of times from the content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1).

Regarding claim 6, Yokono et al. teaches the contents processing system, wherein the processor of the execution device is further capable of performing an operation of transmitting a URL of a web page which is not stored on the medium prepared by the user to the central device when the web page is to be displayed on a browser (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages URL and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1).

Regarding claim 9, Yokono et al. teaches the recording device, wherein the processor is further capable of performing the following operations: storing transmitted contents and the identifier from the outside in a content file in conjunction with each other; and extracting the contents from the content file, based on the identifier of the medium prepared by the user (col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15).

Conclusion

5. *The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP2000285591 Kobe Steel LTD, Nishinaga Koichi et al discloses information distribution terminal 10 ciphering information based on intrinsic IDENTIFICATION information of attachable/detachable devices and charging clients for required information.*

JP 11312175 Sony Corp, Oshima Tsutomu teaches information/music distribution method. When user terminal 2 is connected to the music distribution server 1 and music data of a music program to be downloaded are determined, Table of Content information corresponding

to the music program is sent from the server 1 to the user terminal 2 and stored in a disk-recording medium 9. When the disk recording medium 9 recording only the TOC information is connected to the terminal 3 installed in a CD shop or a convenience store and a prescribed charge is paid, music information corresponding to the TOC information downloaded from the server 1.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.S.

September 11, 2006

NASSER MOAZZAMI
PRIMARY EXAMINER


9, 11, 06